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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/325,019 06/03/99 YOUNG

P PF467

HM12/0727

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EXAMINER

SAUD, C

ART UNIT

PAPER NUMBER

1647

6

DATE MAILED:

07/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/325,019

Applicant(s)  
YOUNG et al.

Examiner  
Christine Saoud

Group Art Unit  
1647



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-23 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, 14-15, 19, and 21, drawn to polynucleotides, vectors, host cells and methods of making a polypeptide, classified in class 435, subclass 69.4, for example.
  - II. Claims 11-12, and 16 drawn to a polypeptide, classified in class 530, subclass 399, for example.
  - III. Claim 13, drawn to an antibody to a polypeptide, classified in class 530, subclass 387.1, for example.
  - IV. Claim 17, drawn to a method of treatment by administration of the polypeptide, classified in class 514, subclass 2, for example.
  - V. Claim 17, drawn to a method of treatment by administration of the polynucleotide, classified in class 514, subclass 44, for example.
  - VI. Claim 18, drawn to a method of detecting a mutation in DNA, classified in class 536, subclass 24.3, for example.
  - VII. Claim 19, drawn to a method of detecting a polypeptide, classified in class 435, subclass 7.1, for example.
  - VIII. Claim 20, drawn to a method of identifying a binding partner, classified in class 436, subclass 501, for example.
  - IX. Claim 22, drawn to a method of identifying an activity in an assay, classified in class 435, subclass 4, for example.
  - X. Claim 23, drawn to a compound of unidentified constitution, class undeterminable, subclass undeterminable.
2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group I could be used in an entirely different method, such as in a method of detection of the polynucleotide in a sample, rather than in a method of making the polypeptide.

4. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group II could be used for an entirely different purpose such as in the method of Group VIII, rather than for the production of antibodies of Group III.

5. Inventions I-III are also are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to chemically different compounds which can be made and used without each other. Furthermore, the inventions of Groups I-III lack a common utility which is based upon a common special technical feature which is disclosed as being responsible for the common utility.

6. Inventions (I-III) and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to chemically different compounds which can be made and used without each other. The structure of the compound of Group X is not defined, however, it would appear that it lacks a common utility which is based upon a common special technical feature (structure) which is disclosed as being responsible for the common utility.

7. Inventions II and (IV, VII and VIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Group II could be used in an entirely different manner, such as in a method of making antibodies rather than in the methods of Groups IV, VII, and VIII.

8. Inventions I and (IV, VII-VIII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the DNA Group I is not required for the methods of Groups (IV, VII-VIII).

9. Inventions I and (V-VI, and IX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for

using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Group I could be used in an entirely different method, such as in the recombinant production of the polypeptide rather than in the methods of Groups (V-VI, and IX).

10. Inventions II and (V-VI, and IX) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the polypeptide of Group II is not required for the methods of Groups (V-VI, and IX).

11. Inventions III and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies of Group III could be used in an entirely different manner, such as in the purification of the polypeptide rather than in the method of Group VII.

12. Inventions III and (IV-VI and VIII-IX) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not required one for the other in that the antibody of Group III is not required for the methods of Groups (IV-VI and VIII-IX).

13. Inventions IV-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods which have different method steps, starting materials and goals.

14. Inventions (IV-IX) and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to methods (Groups IV-IX) which do not require the compound of Group X and which are not disclosed as capable of use

15. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

July 24, 2000

**CHRISTINE SAOUD  
PATENT EXAMINER**

*Christine Saoud*





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